

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kiyotaka Nakano et al.
Patent No. : 7,919,086
Issue Date : April 5, 2011
Serial No. : 10/583,795
Filed : June 21, 2006
Title : ANTI-GLYPLICAN 3 ANTIBODY

Art Unit : 1643
Examiner : Lynn Anne Bristol
Conf. No. : 4422

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO DECISION ON PATENT TERM AND NOTICE OF INTENT TO ISSUE
CERTIFICATE OF CORRECTION

In a Decision on Patent Term and Notice of Intent to Issue Certificate of Correction (“Decision”) dated June 21, 2011, the United States Patent and Trademark Office (“Office”) granted to the extent indicated herein Patentees’ Application For Patent Term Adjustment (PTA) Under 37 C.F.R. § 1.705(d) filed June 6, 2011, for the above-indicated patent. The Office agreed to adjust several periods of time corresponding to Applicant Delay, for a total Applicant Delay of 353 days. The Office did not agree that “B Delay” should not be reduced by 138 days for the period of time under which the application was not undergoing continued examination.

The Office Incorrectly Excluded a Period of Time from B Delay that Does Not Correspond to
Time Consumed by Continued Examination

The Decision stated that the patent is entitled to 183 days of PTA. Patentees maintain that the patent is entitled to 321 days of PTA, for the reasons provided below.

“A Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt response by the Office. It is Patentees’ understanding that there is no dispute that there was one period of A Delay (August 22, 2007, to December 18, 2007) for a total of 119 days.

“B Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. Patentees submit that B Delay accumulated for a total of 653 days, beginning on June 22, 2009 (the day after the date that is three years after the date that the national stage commenced), and ending April 5, 2011 (the date

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the patent was issued). The Office has excluded from B Delay the number of days corresponding to the period beginning on August 13, 2010 (the date on which a Request for Continued Examination was filed), and ending on April 5, 2011 (the date the patent was issued). However, this entire period should not be excluded from B Delay because it does not correspond in its entirety to continued examination. The Notice of Allowance Action mailed on November 19, 2010, closed examination of the application on that date. Section 154(b)(1)(B)(i) of Title 35 excludes from B Delay “time consumed by continued examination of the application.” The statute does not provide for exclusion from B Delay of time from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur).

The legal issue presented in the preceding paragraph is currently the subject of a civil action against the Office in Abbott Biotherapeutics Corp. v. Kappos, 1:2010cv01853 (D.D.C. filed October 29, 2010). The plaintiff in Abbott Biotherapeutics Corp. v. Kappos has argued that the Office improperly calculated the length of the statutory delay period defined by 35 USC 154(b)(1)(B) by subtracting from the delay period the number of days from the mailing of a Notice of Allowance until issuance (a period during which continued examination did not occur). In the event that the Office is unwilling to increase PTA for the present patent in the manner requested herein, Patentees request that a final decision on this petition be held in abeyance pending the final resolution in Abbott Biotherapeutics Corp. v. Kappos. A decision in Abbott Biotherapeutics Corp. v. Kappos will likely settle the legal issue that is central to the present petition.

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Please apply the \$200 petition fee and any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 19672-0003US1.

Respectfully submitted,

Date: August 22, 2011

/RSMcQuade/

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